

## REMARKS

In response to the most recent Office Action, some claims are being amended, many other claims are being cancelled, and new claims of narrower scope added, in order to advance the prosecution of this application. However, the narrowing of the scope of the claims is being done without prejudice against continuing to pursue the broader claims in a continuation of the present application.

Although an objection has been made to claim 22 and a suggestion for changes to the claim made by the Office Action (para. 2, page 2), no amendment is being made since no legal basis for requiring the changes is seen to exist. Claim 22 is submitted to particularly point out and distinctly claim the invention.

### Claims 25, 26, 29 and 30

Independent claim 25 and its dependent claim 26 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. patent no. 5,486,687 ("Le Roux"). Claim 25 has been amended to more particularly recite the differences over Le Roux. New claims 29 and 30 are dependent upon claim 25.

These claims define an electronic card having characteristics of one published card standard including a second integrated circuit chip within the card according to another published card standard, wherein the second integrated circuit chip is electrically connected with the electronic card's physical contacts by electrical conductors within the card and those physical contacts are accessible for contact with a receptacle. It is respectfully submitted that none of these three claimed features is present in Le Roux.

The additional explanation in the current Office Action of the basis for the continuing rejection over Le Roux is appreciated. It is understood from paragraph 11 of the Office Action that the contacts of the connector 12 of Le Roux and the contacts 16 are being considered by the Office Action together in meeting the claim limitation of the "electrical contacts on an outside surface of the card." But it is still not understood whether the rejection is based upon a structure of both of the cards 10 and 18 held together as shown in Figures 2 and 3 of Le Roux, or only upon a structure of the single card 10 as shown in Figure 1.

(a) If the rejection is based upon a structure of both cards 10 and 18 together (Figures 2 and 3), contacts 16 are clearly excluded from the claim by the

added limitation that the external contacts are "accessible for contact with a receptacle into which the card may be removably inserted." The contacts 16 are clearly not externally accessible when both of the cards 10 and 18 are held together in the manner shown in Figures 2 and 3. Additionally, claim 25 specifies that both of the first and second integrated circuit chips and the electrical conductors that connect them with the external contacts are contained within the card, thus excluding the claimed elements being within the two cards 10 and 18 of Le Roux that this construction requires.

(b) If, alternatively, the rejection is based upon the Le Roux structure of a single card 10 (Figure 1) without the card 18 in place, the contacts 16 are then exposed but many other limitations of claim 25 would be missing: the second integrated circuit chip providing a security function, since the card 18 that would not be present, and the claimed connections to it that share common ones of the external card contacts.

If any misunderstanding of how the Le Roux reference is being applied to the claims is believed from the above-discussion to remain, a telephone call from the examiner would very much be appreciated in order for the undersigned attorney to fully understand the basis of the rejection.

Further, new dependent claim 29 specifies a particular arrangement of external contacts that is not present in Le Roux. New claim 30 recites the common use of several of the external card contacts by the both of the first and second integrated circuit chips that provides further novelty over the Le Roux reference.

#### Claims 27 and 28

Independent claim 27 stands rejected under 35 U.S.C. §103(a) over only the Le Roux reference (Office Action, para. 9, page 6). Claim 27 includes part (1) which references "an electronic card" that is similar to that of claim 25, and part (2) that adds "a utilization device for the card" as part of the combination. Part (2) includes a socket having contacts that connect with those of the electronic card. Since the Le Roux reference describes only the card contacts 12 to connect with contacts of the receptacle 30, the contacts 16 cannot then anticipate the external card electrical contacts limitation of part (1) of claim 27. This makes the card itself of part (1) of claim 27 clearly novel

over Le Roux. Le Roux does not disclose a card with first and second integrated circuit chips that are connected to common ones of the external contacts 12 in the specified manner. Contacts 16 cannot be considered as part of the claimed outside card contacts since they are not intended for connection within the receptacle 30.

Additionally, the first and second utilization circuits of the last two paragraphs of claim 27 are not suggested by the single reference (Le Roux) upon which the rejection is based. Rather, the Office Action (para. 9, page 6) summarily concludes that it would have been obvious to incorporate two different circuits into the system of Le Roux, one for reading the security code and the other for reading the data. No prior art has been cited that shows the claimed first and second utilization circuits in a manner to render their addition to Le Roux obvious. Nor has any other evidence been presented as to why such a major change to the system of Le Roux would have been obvious. An objection is hereby made to this taking of Official Notice of facts not present in the single cited Le Roux reference to make a case for obviousness. The first and second utilization circuits recited in part (2) of claim 27 are clearly novel over Le Roux and no *prima facie* case of the obviousness of including them in the claimed combination has been made.

It is therefore believed that two clear distinctions exist in claim 27 over Le Roux, one in the card of part (1) of the claim and the other in the utilization device of part (2).

#### New Claims 31-36

New independent claim 31 is similar to claim 25, but of somewhat different scope and using some different terms of limitation. However, it is believed that claim 31 is patentable over the cited Le Roux reference for the same reasons discussed above with respect to claim 25, with the same assumptions with regard to the bases for rejecting claim 25 being made as discussed above. Dependent claims 32-35 additionally specify functions of individual ones of the external card contacts in connection with each of the first and second integrated circuits that are not even remotely suggested by Le Roux. Dependent claim 36 defines the type of the second integrated circuit chip, also not suggested by Le Roux. Examination and allowance of the new claims is respectfully requested.

#### Claims 22-23

Independent claim 22 and its dependent claim 23 have been rejected in the Office Action (para. 9, page 6) under 35 U.S.C. §103(a) over only the Le Roux reference. It is acknowledged in the Office Action that the circuits recited in the last two paragraphs of claim 22 are not suggested by the single cited Le Roux reference, and no other reference is cited to form the obviousness rejection. Rather, the Office Action summarily concludes that it would have been obvious to incorporate the two different circuits into the system of Le Roux, one for reading the security code and the other for reading the data. An objection is hereby made to this taking of Official Notice of certain facts to make a case for obviousness. The circuits recited in the last two paragraphs of 22 are clearly novel over Le Roux and no *prima facie* case of the obviousness of including them in the claimed combination has been made. Reconsideration of the rejection of claims 22 and 23 is respectfully requested.

#### Claim 24

Independent claim 24 stands rejected (Office Action, para. 7, pages 4-5) under 35 U.S.C. §103(a) over a combination of the Le Roux reference and U.S. patents nos. 5,278,395 ("Benezet") and 6,002,605 ("Iwasaki"). It is respectfully submitted that this rejection is not well taken.

The rejection is based upon the alleged obviousness of adding two defined circuit functions to the receptacle 30 of Le Roux for separately operating the memory card 10 and the security card 18. Claim 24 requires that both cards be insertable into the card slot and connected through the slot to the recited security and card interface circuits. Le Roux, however, describes a system where only the memory card 10 is connected through the receptacle 30. The security card 18 instead connects directly with the memory card 10 through contacts 16, and not through the receptacle 30. Le Roux's description leaves no doubt that the direct connection is provided between the two cards so that the memory card 10 interacts directly with the security card 18 to enable access through the receptacle 30 of the memory card 10. "Instead of the security card [10] communicating directly with the microcomputer [through the receptacle 30], it will communicate with the mass memory card, whose security it is to ensure." (Le Roux, col. 2, lines 32-37, with words in brackets added.) So not only are contacts of Le Roux's security card 18 not physically

accepted by contacts of the receptacle 30, Le Roux positively teaches that there is no direct communication of the security card with circuits connected with the receptacle.

In light of this positive disclosure, it is respectfully submitted that Benezet would not have rendered it obvious to modify Le Roux's system in direct contradiction with Le Roux's disclosure. Nothing has been found in Benezet that would have provided motivation for such a fundamental change in Le Roux. Such a change would have made it necessarily to ignore and drastically change what Le Roux states to be of key importance to its system.

In addition, Benezet is directed to use of its security card to directly allow the host system such as an auto parking device to deduct amounts from a prepaid second card, in an electronic business transaction. No motivation in the description of the cited Iwasaki reference has been found to have caused the Benezet system to be changed to provide security for replaying sound from a memory card instead of conducting electronic business transactions. Indeed, Iwasaki appears to emphasize a utilization device that has two card slots, one for the card containing the data being utilized and the other for the security card that controls operation of the utilization device. Claim 24, on the other hand, specifies a card slot into which both cards are inserted in sequence, one at a time. If Iwasaki would have made it obvious to modify Benezet, as alleged in the Office Action, it seems that such a modification would have included adding a second card slot in order that both cards could be connected to the utilization device at one time. This, of course, is contrary to what is specified in claim 24. Reconsideration of this three reference obvious rejection is respectfully requested.

#### Information Disclosure Statements

The form 1449 submitted by the undersigned with an Information Disclosure Statement was returned with the present Office Action with 3 of the 4 listed references having been initialed by the Examiner as having been considered but the 4<sup>th</sup> reference not so initialed. Therefore, a copy of this form 1449 is attached. Consideration of the listed document AI and a notation thereof on the form 1449 are respectfully requested.

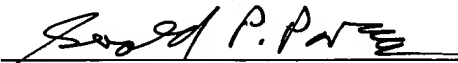
The Office Action notes that reference EP 0 775 964 was cited as an "X" reference in a PCT search report of the corresponding PCT application. As pointed out on the last page of that search report, this published European patent application has a

corresponding U.S. patent no. 6,097,605. It is this U.S. patent that was cited by an Information Disclosure Statement and already considered by the Examiner.

Conclusion

Accordingly, it is believed that this application is now in condition for allowance and an early indication of its allowance is solicited. However, if the Examiner has any further matters that need to be resolved, a telephone call to the undersigned attorney would be appreciated.

Respectfully submitted,



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